IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	) **MAIL STOP AF**
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Hajime Takei et al.	) Group Art Unit: 2625
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Application No.: 09/970,702	) Examiner: Marcus Riley
	)
Filed: October 5, 2001	) Confirmation No.: 1791
	)
For: PRINTING SYSTEM, AND PRINT SERVER AND COMPUTER PROGRAM USED IN SAID PRINTING SYSTEM	)))))
	)

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated January 19, 2011, Applicants request a Pre-Appeal Brief Conference to review the rejections. Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 - 19, and 22 - 27 are rejected under 35 U.S.C. § 102(e), on the basis of US 6,873,426, hereinafter *Farrell*. Claims 3, 6, 9, 12, 15 and 20 were rejected under 35 USC 103(a) on the basis of *Farrell* in view of *Jeyachandran* (US 6,567,176). Claim 21 was rejected on the basis of *Farrell* in view of *Jeyachandran* and *Trovinger* (US 6,708,967).

Farrell discloses only one finisher and the given and the "substitute finishing" operations are performed by the one finisher:

Claim 1 recites, among other features, a first memory for storing the first set of finishing specifications capable of being performed by the on-line printer and the second set of finishing specifications capable of being performed by the off-line finishing device. Claim 1 further recites that finishing specifics included in a job ticket are separated into two groups, one group capable of being performed by the on-line printer and the second group capable of being performed by the off-line finishing device. According to claim 1, those of the selected finishing specifics capable of being performed by the on-line printer are assigned to the on-line printer, and those

of the selected finishing specifics capable of being performed by the off-line finishing device are assigned to the off-line finishing device.

In contrast, *Farrell* cannot teach separating finishing specifics into the two recited groups since the *Farrell* system includes **only one device** that is operative to perform finishing, i.e., the finisher 18. The print module 34 has no finishing capabilities. Accordingly, *Farrell* cannot teach the claimed separating and assigning steps.

In response to this argument, which has been previously made, the Examiner recites:

> Examiner understand applicant's argument but respectfully disagree. Farrell '426 explains at column 3, lines 16-17 and column 5, lines 9-22 that the finishing instructions can reside, for example, in the finishing element 18 itself or within a memory in the system 10. A second finishing instruction is substituted which corresponds to a second finishing operation. The job may be prepared with the finishing capabilities existing on the print machine, or with detailed abstract finishing denoting the finishing operation to be later performed with the finisher 18.

The Examiner's comment reflects a basic misunderstanding of the teachings of *Farrell*. In the sections of *Farrell* recited by the Examiner, all finishing operations, both the given instructions and the substitute instructions, are performed **by the same finisher** 18. What *Farrell* teaches is that if a specifically requested finishing operation cannot be performed by the finisher 18, the instructions are changed so that a finishing operation that can be performed by the same finisher 18 is used instead. ("In this case, the print job can be completed with the alternate finishing instruction, executed by the compatible finishing equipment 18 on the print system, as illustrated in step 34." Column 5, lines 19 - 22)

The Examiner further states:

> Farrell '426 at Fig. 2 also discloses a sorter, Image Output controller 28. For example, column 4, lines 25-42 explains that with reference to Fig. 2, upon a determination to proceed with the print job, the system controller 24 directs an image output controller 28 to synchronize and output the image to the printer section 16. Steps 40-64 explains how a job may be sorted and prepared with the finishing capabilities existing on the print machine or substitute finishing wherein the system controller 24 will retrieve alternate finishing instructions which are compatible with the finishing installed element 18 as in step 50.

Thus, even the Examiner acknowledges that the alternate or substitute finishing instructions are completed by the very same finisher 18. The substitute finishing instructions referred to by the Examiner are explained at column 4, lines 13 - 20: "However, system controller 24, upon a determination that the desired finishing is unavailable, can substitute alternate finishing instructions which are compatible with available finishing equipment (substitute literal finishing)."

The Farrell off-line finisher is not a working device:

The Examiner, at the bottom of page 4 of the Office Action, refers to the finisher 18 as **the off-line finishing device**. However, that reference is also an incorrect interpretation of *Farrell*. As support for the (incorrect) allegation that the finisher 18 can work off-line, the Examiner refers to column 3, lines 16 - 17. A better explanation is found at column 4, lines 8 - 12, wherein it states: "Unfortunately, if the finishing element 18 is off line, is in an error state, is not compatible with the desired finishing instruction, or is otherwise unavailable, an error message is typically generated and displayed to a user and the print job is suspended." Thus, it is clear that the reference to the finishing device being off-line means that the finishing device is not working.

Abstract Finishing:

Farrell does teach a concept called "abstract finishing". See column 4, lines 47 - 49, and column 5, lines 23 - 38. According to *Farrell*, if a requested finishing operation cannot be performed by the finisher 18, a choice is made between using the finisher 18 to perform a substitute finishing operation with the finisher 18, as discussed above, or to invoke "abstract finishing". If "abstract finishing" is invoked, the job is run with slips of paper or markers indicating that the requested finishing operation was not performed. See column 5, lines 23 - 38. However, there is no teaching in *Farrell* that the system prepares a job ticket from a list of finishing operations **obtained from a memory** that can be performed by an off line finishing device. In fact, *Farrell* never discloses how the "abstract finishing" is completed.

As such, *Farrell* clearly does not teach or suggest the claimed combination that includes "a sorter for separating the finishing specifics included in the job ticket received by the receiver into finishing specifics selected from the stored first set of

finishing specifics capable of being performed by the online printer, and ***finishing specifics selected from the stored second set of finishing specifics capable of being performed by the off-line finishing device***, wherein those of the selected finishing specifics capable of being performed by the on-line printer are assigned to the on-line printer, and those of the selected finishing specifics capable of being performed by the off-line finishing device are assigned to the off-line finishing device." There is no teaching in *Farrell* of an off-line finishing device having a list of finishing specifics stored in a memory of the printing system. As set forth above, *Farrell* never discloses how the "abstract finishing" is completed.

Farrell does not disclose a printing system that stores information about an on-line printer <u>and</u> a distinct, i.e., off-line, finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

It is respectfully submitted that the system of the *Farrell* patent does not anticipate, nor otherwise suggest, the claimed subject matter. First, it does not store in memory first <u>and second </u>sets of specifications that respectively correspond to the capabilities of an on-line printer and an off-line finishing device. At best, the print controller only has knowledge of the capabilities of the printer.
Second, it does not separate finishing specifics in a job ticket into two groups that respectively comprise (i) finishing specifics selected from a <u>stored</u> first set corresponding to the capabilities of the printer, and (ii) finishing specifics selected from a <u>stored</u> second set corresponding to the capabilities of an off-line finisher. To the extent that the *Farrell* patent suggests separation into two groups, those groups respectively comprise the functions that **can** be performed by the printer, and those

functions that **cannot** be performed by the printer. Nowhere does the *Farrell* patent suggest that the substitute literal finishing or the substitute abstract finishing (described at column 4, lines 12-20) is based upon a set of stored capabilities of an off-line finisher. In fact, the print controller of the *Farrell* patent is not described as having knowledge of the capabilities of any particular off-line finishing device.

Independent claims 4, 7, 10, 13, 16, 22 and 24-26 have been amended in a manner analogous to claim 1, and recite the distinguishing features discussed above. As such, these other independent claims are likewise not anticipated by the *Farrell* patent. For at least these same reasons, dependent claims 2, 5, 8, 11, 14, 17-19, 23 and 27 are also not anticipated.

Claims 3, 6, 9, 12, 15, 20, and 21 are rejected under 35 USC 103(a) on the basis of the *Farrell* patent in combination with U.S. patent No. 6,567,176, hereinafter *Jeyachandran.* For claim 21, U.S. Patent No. 6,708,967, hereinafter *Trovinger* is also used in the rejection. However, the features relied upon from *Jeyachandran* do not overcome the deficiencies set forth above with regard to *Farrell.*

With regard to *Trovinger,* the Office Action asserts that the finishing device is an off-line device. However, that also does not overcome the fact that *Farrell* does not teach or suggest the distinguishing features identified above. Accordingly, neither *Jeyachandran* nor *Trovinger* overcome the inability of *Farrell* to support a rejection of the claims.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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